

REMARKS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-7 were pending, and at present Claims 1-7 stand rejected. Claims 1, 2, 4, 5 and 6 have been amended. Claim 7 has been canceled without prejudice. Claims 8-10 are new. Claims 1-6 and Claims 8-10 are patentably distinguishable over the prior art and considered allowable.

New Claims 8-10 include subject matter unanticipated and/or undisclosed by the prior art, including the wireless communication means, activation means and central monitoring within a wrist watch. Therefore, Claims 8-10 are patentably distinguishable over the prior art.

Rejections

(A) The examiner respectfully rejected Claims 1, 4, 6 and 7 under 35 U.S.C. § 102(b) as being anticipated by Ladner.

In undertaking to determine whether one reference anticipates another under 35 U.S.C. 102(b), a primary tenet is that the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant has amended Claim 1 to recite limitations and features unanticipated by Ladner, including a traditional pager enclosure adapted so as to enclose the personal safety signaling apparatus, with the traditional pager enclosure incorporating activation means located on a front panel thereof to facilitate operation of the personal safety signaling apparatus, and wherein activation means is prevented from accidental triggering via an activation means cover guard. Ladner fails to disclose or claim the combination of a wireless communication means, activation means, a pair of wireless links, a central monitoring station and a pager enclosure. Thus, Applicant submits that Claim 1 (as amended) is patentably distinguishable over and not anticipated by Ladner. Furthermore, Claims 2 and 3, dependent from amended Claim 1, are also patentably distinguishable over and not anticipated by Ladner for the reasons cited previously.

Claim 4 recites similar limitations as those in Claim 1, with the exception that Claim 4 includes a land link between first communication means and the central monitoring station. Ladner fails to disclose or claim the combination of a wireless communication means, activation means, a pair of wireless links, a central monitoring station, a land link between the first wireless link and the central monitoring station and a pager enclosure. Thus, Applicant submits that Claim 4 (as amended) is patentably distinguishable over and not anticipated by Ladner. Furthermore, Claims 5 and 6, dependent from amended Claim 4, are also patentably distinguishable over and not anticipated by Ladner for the reasons cited previously.

Therefore, Claims 1-6 are patentably distinguishable over the prior art. Withdrawal of this rejection is respectfully requested.

(B) The examiner respectfully rejected Claims 2, 3 and 5 under 35 U.S.C. § 102(b) as being unpatentable over Ladner in view of Sheffer.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j).

Claims 2 and 3 depend from amended Claim 1, which is presently considered patentably distinguishable over Ladner, thus Claims 2 and 3 are also considered patentably distinguishable over the prior art. Claim 5 depends from amended Claim 4, also considered patentably distinguishable over the prior art. The combination of Ladner and Sheffer fail to disclose the combination of elements and functions of a wireless communication means, activation means, a pair of wireless links, a central monitoring station and a pager enclosure, and furthermore fail to disclose the additional combination of a microphone and a second wireless communication means. Thus, Claims 2, 3 and 5 are patentably distinguishable over the combination of Ladner and Sheffer.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every

element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a personal safety signaling apparatus having wireless communication means, activation means with a guard, central monitoring station, a pager enclosure housing the wireless means and activation means. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention.

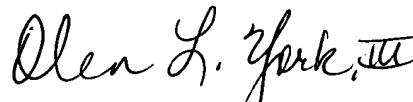
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However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,



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